REMARKS

In view of the following remarks, reconsideration of the outstanding office action is respectfully requested.

The Office has rejected claims 1, 2, 4-7, 9-11, 13-16, 18-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,438,657 to Nakatani (Nakatani), in view of US Patent No. 7,197,702 to Niyogi et al. (Niyogi), and further view of US Patent No. 6,088,711 to Fein et al (Fein), claims 3, 12, and 21 under 35 U.S.C. 103(a) as being unpatentable over Nakatani in view of Niyogi in view of US Patent (Fein), and further in view of US Patent No. 6,778,703 to Zlotnick (Zlotnick), and Claims 8, 17, and 26 under 35 U.S.C. 103(a) as being unpatentable over Nakatani in view of Niyogi in view of Fein and further in view of US Patent No. 6,519,617 Wanderski et al. (Wanderski).

Nakatani, Fein, Zlotnick, Niyogi, and Wanderski, alone or in combination, do not disclose or suggest, "wherein the mutation system determines which of the one or more mutators to apply based on one or more characteristics of the designated output system" as recited in claim 1, "wherein the applying further comprises determines which of the one or more mutators to apply based on one or more characteristics of the designated output system" as recited in claim 9, or "wherein the applying further comprises determines which of the one or more mutators to apply based on one or more characteristics of the designated output system" as recited in claim 18.

The Office has asserted "Nakatani and Niyogi et al does not expressly teach to form a mutated portion in the original document, having obtained one or more mutators from a list of stored mutators which correspond to particular types of documents, wherein the mutation system determines which of the one or more mutators to apply based on one or more characteristics of the designated output system and the type of document that matches the portion of the original document."

However, the Office cites to the Abstract and Fig 2A in Fein as teaching to form a mutated portion in the original document. having obtained one or more mutators from a list of stored imitators which correspond to particular types of documents, wherein the mutation system determines which of the one or more mutators to apply based on one or more characteristics of the designated output system and the type of document that matches

the portion of the original document. The Office asserts "whereas a list of mutators/properties are obtained, that correspond to particular types of paragraph documents, wherein one or more properties/mutators are applied based on one or more characteristics of the designated output/defining algorithm/system (such as the characteristics of a plurality of conditional logic statements implemented in the algorithm of Fig 2A), and the type of paragraph document that matches the portion of the original paragraph document)."

Contrary to the Office's assertion Fein teaches <u>applying a style of a paragraph based upon the formatting properties of the paragraph</u>, such as for example, matching the <u>same paragraph type</u> to <u>the paragraph type of the original paragraph</u>. The Office believes that Fein's "*style of a paragraph*" is analogous the Applicants' claimed mutators. However, Fein fails to teach determining which "*style of a paragraph*" to use <u>based on the characteristics of an output device</u> on <u>which the original document is going to be displayed</u>, e.g., a printer as recited in claims 1, 9, and 18. By way of example only, the Office's attention is directed to the Abstract of Fein, which states:

> "A method and system for defining and <u>applying a style of a paragraph based upon the formatting properties of the paragraph</u>. The paragraph type of the paragraph is identified. A determination is made whether the paragraph type is one which is capable of having a style defined for it. If not, then a determination is made whether the major formatting properties of the paragraph <u>match</u> those of <u>an existing style</u> and, if so, <u>then the matching existing style is applied to the paragraph</u>. If the paragraph type is one which is capable of having a style defined for it, then a determination is made whether <u>the major formatting properties of the paragraph match the those of an existing style</u> with the <u>same paragraph type</u> as <u>the paragraph type</u> of the paragraph. If so, then the <u>matching existing style is applied to the paragraph</u>. If not, then a style is defined with the formatting properties of the paragraph. <u>The defined style is then applied to the paragraph</u> and all direct formatting is removed." (emphasis added)

In this regard, it is noted that all Figures and teachings throughout Fein illustrate and describe identifying <u>a paragraph type</u> of <u>a paragraph</u> and, based upon the <u>formatting properties of the paragraph</u>, defining a style for the paragraph and applying the style to the paragraph. However, Fein fails to teach or disclose determining or applying a paragraph style based on the characteristics of the output device on which the original document is going to be displayed, e.g., a printer. Similarly, Nakatani, Zlotnick,

Niyogi, and Wanderski, does **not** disclose or suggest the aforementioned claimed limitation.

In sharp contrast, the present invention determines which of the mutators to use based on the characteristics of the output device on which the original document is going to be displayed, e.g., a printer. By way of example only, the Office's attention is directed to paragraph [0025], lines 17-26 of the above-identified patent application:

> "[0025] In step 110, the document processing system 12 determines which of the one or more mutators obtained from the identified, stored document to use on the selected portion of the original document. The document processing system 12 determines which of the mutators to use based on the characteristics of the device on which the original document is going to be displayed and based on one or more elements of the original document, although other manners for determining which of the mutators to select can be used. For example, if the printer 14 selected for the printing job is a black and-white printer, then a mutator for altering color obtained from the identified, stored document is irrelevant and would not used by the document processing system 12."

Accordingly, neither Nakatani, Fein, Zlotnick, Niyogi, nor Wanderski, alone or in combination, teach or suggest determining which of the one or more stored mutators to apply based on one or more characteristics of the designated output system, as recited in claims 1, 9, and 18.

Additionally, Nakatani, Fein, Zlotnick, Niyogi, and Wanderski, alone or in combination, do not disclose or suggest, "one or more mutators to apply based on one or more characteristics of the designated output system and the type of document that matches the portion of the original document." as recited in claim 1, and "one or more stored mutators to apply based on one or more characteristics of the designated output system and the type of document that matches the portion of the original document." as recited in claim 9, and "one or more stored mutators to apply based on one or more characteristics of the designated output system and the type of document that matches the portion of the original document." as recited in claim 18.

The Office asserts "Nakatani and Niyogi et al does not expressly teach to form a mutated portion in the original document, having obtained one or more mutators from a list of stored mutators which correspond to particular types of documents, wherein the mutation

system determines which of the one or more mutators to apply based on one or more characteristics of the designated output system and the type of document that matches the portion of the original document."

However the Office relies on Fein to overcome the deficiencies Nakatani and Niyogi citing to the Abstract and Fig 2A of Fein and stating "whereas a list of mutators/properties are obtained, that correspond to particular types of paragraph documents, wherein one or more properties/mutators are applied based on one or more characteristics of the designated output/defining algorithm/system (such as the characteristics of a plurality of conditional logic statements implemented in the algorithm of Fig 2A), and the type of paragraph document that matches the portion of the original paragraph document)."

As mentioned above, Fein fails to teach or disclose determining or applying a paragraph style based on the characteristics of the output device on which the original document is going to be displayed as claimed. Fein is directed to identifying *a paragraph type* of *a paragraph*. (The paragraph type is a general, functional description of the paragraph. For example, the paragraph type may be a heading or body text.) and, based on *formatting properties of the paragraph*, defining a style for the paragraph and applying the style to the paragraph. Thus, Fein's matching paragraph style is only applied based on *properties of the paragraph* and **not** on *one or more characteristics of the designated output system* **and** the *type of document* that matches the portion of the original document as claimed. By way of example only, the Office's attention is directed to the Abstract of Fein, which states:

> "A method and system for defining and underline applying **a style of a paragraph based upon the formatting properties of the paragraph**. The paragraph type of the paragraph is identified. A determination is made whether the paragraph type is one which is capable of having a style defined for it. If not, then a determination is made whether the major formatting properties of the paragraph match those of an existing style and, if so, **then the matching existing style is applied to the paragraph**. If the paragraph type is one which is capable of having a style defined for it, then a determination is made whether the major formatting properties of the paragraph match the those of an existing style with the same paragraph type as the paragraph type of the paragraph. If so, then the matching existing style is applied to the paragraph. If not, then a style is defined with the formatting properties of the paragraph. The defined style is then applied to the paragraph and all direct formatting is removed." (emphasis added)

Accordingly, Fein is completely silent regarding applying its paragraph style to a paragraph *based on one or more characteristics of the designated output system **and** the type of document that matches the portion of the original document* as claimed. Fein teaches if the major formatting properties of the paragraph **match** those of an existing paragraph style with the same paragraph type of the paragraph. Then the matching existing style is only applied to the paragraph portion of the document. Similarly, Nakatani, Zlotnick, Niyogi, or Wanderski, do **not** disclose or suggest the aforementioned claimed limitation.

In sharp contrast, the present invention selects a mutator from a list of stored mutators and then applies the mutator based upon *one or more characteristics of the designated output system* **and** *particular types of documents such as for example, text documents, documents with text and images, and documents with images* that matches the original document. By way of example only, the Office's attention is directed to paragraph [0025] of the above-identified patent application:

> [0025] In step 110, the document processing system 12 determines which of the one or more mutators obtained from the identified, stored document to use on the selected portion of the original document. **The document processing system 12 determines which of the mutators to use based on the characteristics of the device on which the original document is going to be displayed and** based on one or more elements of the original document, although other manners for determining which of the mutators to select can be used. For example, if the printer 14 selected for the printing job is a black-and-white printer, then a mutator for altering color obtained from the identified, stored document is irrelevant and would not used by the document processing system 12. In another example, the document processing system 12 could have **lists of mutators stored in memory 20 which are associated with particular types of documents, such as for text documents, documents with text and images, and documents with images, and** then the document processing system 12 would determine to use the obtained **mutators** that were on appropriate **stored list for the type of document** that matches the portion of the original document or the original document. (Emphasis added)

Additionally, Nakatani, Zlotnick, Niyogi, or Wanderski, alone or in combination, do not disclose or suggest the aforementioned limitation. Thus, there is no mention in Nakatani and Niyogi of "wherein the mutation system determines which of the one or more mutators to apply based on the type of document that matches the portion of the original document." as recited in claim 1, and "wherein the applying further comprises determines which of the one

or more stored mutators to apply based on the type of document that matches the portion of the original document." as recited in claims 9 and 18. Therefore, Applicants can find no suggestion in Zlotnick or Niyogi to combine the teachings of Zlotnick and Niyogi with Fein, as suggested by the Office, except from using Applicants' invention as a template through a hindsight reconstruction of Applicants' claims. As a result, it would **not** have been obvious to one of the ordinary skill in the art at the time of the invention to have modified the combination of Nakatani and Niyogi with Fein because Fein is only directed to modifying the paragraph portion of the document based only based on *properties of the paragraph* and **not** on *one or more characteristics of the designated output system* **and** the *type of document that matches the original document* as recited in claims 1, 9, and 18.

Accordingly, in view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejection of claims 1, 9, and 18. Since claims 2-8 and 27 depend from and contain the limitations of claim 1, claims 10-17 and 28 depend from and contain the limitations of claim 9, and claims 19-26 and 29 depend from and contain the limitations of claim 18, they are distinguishable over the cited references and patentable in the same manner as claims 1, 9, and 18.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: October 20, 2011   /Gerald F. Gibbs, Jr./
                                          Gerald F. Gibbs, Jr.
                                          Registration No. 64,715

LECLAIRRYAN
290 Linden Oaks
Suite 310
Rochester, New York 14625
Telephone: (585) 270-2117
Facsimile: (585) 270-2179